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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,010	12/04/2000	Thomas R. Jenkins	15916-277	6595

7590 07/03/2002

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EXAMINER

DAGOSTINO, SABRINA

* ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 07/03/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,010

Applicant(s)

JENKINS ET AL.

Examiner

Sabrina Dagostino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-10,31-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☒ Claim(s) 14,15 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### **DETAILED ACTION**

1. We hereby acknowledge applicant's selection of Group I and III, without traverse, as described in the Office Action Summary dated 4/22/02. The claims relating to the selection are claims 11-30.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner cannot determine what function the claimed "slot" has from the specification.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11, 12, 14, 15, 21- 25, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Avitall (5263493).

Please note that the "Y" section below the element 22, in Fig. 1A is broadly considered to be a hinge.

6. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Imran (5782899).

See Col. 2, Lines 28-32.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avitall (5263493) in view of Osypka (5738683).

The applicant discloses a probe with at least one sensing element which is located on either the distal or proximal portion of the body. Avitall discloses almost the same subject matter except that it doesn't have a sensing element. Osypka discloses a temperature sensor which is carried by the distal end portion. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the probe of Avitall such that it had a sensor for the purpose of sensing temperature as taught in Osypka.

10. Claims 17 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avitall (5263493) in view of Chu et al. (5967984).

The applicant discloses a probe comprising a half-balloon structure. Avitall discloses almost the same subject matter except that it doesn't have a half-balloon structure. Chu et al. discloses a catheter whereby a half-balloon can be added to provide stabilization during the cutting procedure (See Col. 12, Lines 3-6). Therefore, it would have been obvious to one having

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ordinary skill in the art at the time the invention was made to modify the probe of Avitall such that it had a half-balloon for the purpose of providing stabilization as taught in Chu et al.

11. Claims 18 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avitall (5263493) in view of Abiuso et al. (5213576).

The applicant discloses a probe that comprises an inflatable tissue coagulation body including micropores. Avitall discloses almost the same subject matter, except that it does not have micropores. Abiuso discloses a balloon catheter, which carries an array of micropores. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the probe of Avitall such that it had micropores for the purpose of ionic transportation as taught in Abiuso et al.

12. Claims 19 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avitall (5263493) in view of Saito et al. (5380319).

The applicant discloses a probe comprising an inflatable tissue coagulation body with a heated structure. Avitall discloses almost the same subject matter, except that it does not include a heated structure. Saito et al. discloses a balloon catheter enclosing a high frequency warming electrode. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the catheter of Avitall such that it had a heated structure for the purpose of heating the tissue as taught in Saito et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Dagostino whose telephone number is 703-306-3485.

The examiner can normally be reached on M-F 7-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Sabrina Dagostino  
Examiner  
Art Unit 3743

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July 1, 2002